

IN SENATE OF THE UNITED STATES.

MARCH 2, 1848.

Submitted, and ordered to be printed.

Mr. WESTCOTT made the following

REPORT:

*The Committee on Patents and the Patent Office, to whom was referred the petition of Herrick Aicken, praying an extension of his patent for "an improvement in the saw-set," &c., report:*

That a similar petition was presented to the Senate February 3d, 1845, and referred to the same committee. No law passed in accordance with the prayer of the petition.

The following are the only papers filed with the petition:

1. A paper purporting to be a printed copy of his letters patent and specifications, &c.; dated 24th March, 1833, not certified or otherwise authenticated.

2. A paper purporting to be a printed copy of his protest against the decision of "*the board*" refusing to extend his patent. This appears to have been addressed to Mr. Ellsworth, former Commissioner of Patents, &c., and is dated June 4, 1844. It is not authenticated.

3. A printed schedule of articles stated to be improvements and inventions of the patentee, not authenticated, but of which articles he states specimens are deposited in the Patent Office.

4. A printed handbill or advertisement, with wood cuts of the invention of the petitioner, for which he desires his patent renewed.

The petitioner has neglected to adduce to the committee any evidence whatever, except that furnished by these papers. The testimony before the board, and upon which it refused to extend his patent, has not been laid before the committee, though the petitioner asks that Congress shall in effect, by a special act, *reverse* that decision. Without some *proof* of circumstances showing that petitioner should have granted to him an extension of his patent, as prayed by him, either from considerations of public benefit, or on account of his superior claims from other considerations, Congress should not grant his application. Nor should he expect that the committee will seek to ascertain where the *proofs* of the merits of such application may be found, beyond the testimony filed with the petition, and then to search for, and adduce them. The petitioner must procure and present them with the petition.

Prior to the act of 4th July, 1836, regulating the Patent Office, (vide 5th vol. stat. at large, pp. 117, 124,) patents were extended or renewed only by special act of Congress. Adopting the liberal principles of Lord Brougham's bill amending the patent laws of England, passed in 1835, (vide Kingsley's and Prisson's Patent Laws, pp. 77, 79, &c.,) Congress, by the 18th section of the law before cited, [made the Secretary of State, the Solicitor of the Treasury, and the Commissioner of Patents a "board" to receive applications for the extension of patents, prescribing, with great particularity, the mode of proceeding by the applicant, the character of the testimony he should adduce to the board, and the principles by which it should be guided in the extension of patents.

These provisions are liberal to a patentee who may not have received adequate remuneration or reward for his invention. They are general, embracing nearly every case in which a patent should be renewed.

If cases occur of peculiar character and merit, which, from extraordinary circumstances, may not be within these provisions, and as to which the board have no power to grant an extension, and in which the patentee can show grounds for an application to Congress for special relief, it is not denied that Congress may and should extend such relief. Cases may possibly happen, also, in which, though the board had full jurisdiction, its decision, refusing to extend a patent, should not be conclusive upon Congress, and in which upon application of a patentee, Congress should even disregard such decision of the board, and extend the patent by a special law. But special legislation should always be avoided, except in cases of peculiar and extraordinary merit and necessity. The primary object of the 18th section of the act of 1836, was to provide an impartial tribunal for the decision of such questions upon settled rules and principles, and avoid the necessity of applications to Congress for such special laws. Patentees, having full remedy under the general law, by application to the board, as the law prescribes, should be discouraged from applying to Congress, by a denial of the relief sought, till they resort to such general remedy provided by that general law; and which, it is repeated, is of the most liberal character. It is true, by the constitution of the United States, (vide Art. 1, amendments,) Congress cannot make any law "abridging the right of petition;" but the action of Congress upon petitions unnecessarily or improperly preferred, may, with entire propriety, be such as to discountenance their presentation. It has been urged, that it is not an abridgment of this franchise of petition for the redress of a grievance, public or private, to require that it shall not be prostituted by its use as the medium of proclaiming treasonable, or incendiary, or immoral sentiments, hostile to the constitutional institutions of the country, or libellous with respect to individual citizens, and also to prohibit the use of insulting and disrespectful language towards the body to which it may be addressed; but differences of opinion have existed as to the extent to which such restrictions may be rightfully enforced by Congress. These rules do not however, apply to the principle

just advanced with reference to respectful memorials upon proper subjects, and as to the form, and style, and length of which, the citizen may rightfully consult his own taste and fancy. Either house may, by its rules, prescribe what a petition for the extension of a patent or for any such special law shall set forth, and the character and degree of proof that shall be adduced to entitle it to favorable consideration, even though it may not refuse to *receive* petitions on such subjects not conforming to such rules.

The multiplicity of recent applications to Congress for the extension of patents by special act, has induced the committee to make some suggestions as to the general rules and principles that should govern in regard to such applications, which it may be well for applicants to conform to.

In all cases, a copy of the patent sought to be extended, duly certified, and also of all official documents relating thereto, should be filed with the petition.

In no case where the board has, under the 18th section of the act of 1836, before cited, jurisdiction of an application to extend a patent, and in which no special reasons exist excusing the party for dispensing with such application, should Congress favorably entertain a petition to extend a patent until such jurisdiction has been resorted to. And, where reasons exist for not invoking the action of the "*board*," they should be distinctly stated and proved.

In cases where the board has no jurisdiction, and could not therefore extend the patent, that fact, and the reasons why the case is not within the jurisdiction of the board, should be clearly shown by applicants.

In all cases in which application has been made to the "*board*," and the extension refused, (as it is sought to rescind the decision of the *board*, and reverse it,) an exemplified copy of the application to the board, and of all the proofs before it, and of all its proceedings, should be filed by the petitioner, and the grounds for the application to Congress for the renewal or extension, should be explicitly and distinctly stated.

In all cases, full proof by affidavit of persons certified to be of good character, and entitled to credit, and disinterested in the matter, should be adduced, substantially as required by the 18th section of the act of 1836, to the following points:

1. As to the value, merits, novelty and utility of the invention, its cost of manufacture or construction, &c.

2. As to the patentee's receipts and expenditures; respectively, in detail, as far as possible; as to his sales and expenses thereof; and as to the time, trouble, labor and expense in bringing his invention into use; and a faithful account of loss and profit in any manner accruing to him from and by his invention.

3. As to any litigation he may have encountered with respect to it, stating the same particularly, and the expenses thereof, and the result thereof.

4. Showing, that without fault or neglect on part of patentee, he has failed to obtain from the use or sale of his invention a rea-

sonable remuneration for his time, ingenuity, expense, labor, trouble, &c., bestowed upon the same, and the introduction thereof into use.

5. As to all transfers or assignments he may have made of such patent right, or of the right to use the thing patented, and showing that such assignees, and others interested, have notice of the application to Congress for such extension, so that injustice may not be done to third persons by their not being apprised of such application, and being therefore without opportunity to oppose such extension. If Congress is without power to prescribe, in advance of such petition, that it will not *receive* it until such full public notice is given, it is not to be doubted that its action upon such petition may, and properly should be, influenced unfavorably, unless full notice is given to the world, and especially to those who may be interested, to dispute the claim of the petitioner to the extension asked. Notice is required, by the 18th section of the act of 1836, upon an application for an extension to the "board." As the patent is not conclusive evidence either of the novelty and utility of the thing patented, or that the patentee is the inventor, (vide section 15, act of 1836, *et passim*,) all who may dispute the validity of the patent on such grounds, should have fair opportunity of being heard before the enactment of a special law which may conclude them, and the petitioner should be prepared to show he is the *inventor*.

6. If any special circumstances exist in a case entitling a petitioner to the favorable consideration of Congress, they should not only be distinctly stated, but *proved*.

7. All papers filed should be legally authenticated.

The absence of the proofs above stated, or disregard of the rules suggested, should, in every case, cause the rejection of an application for an extension.

Elaborately extended statements, essays, arguments, and explanations in writing and letters from public men, or importunate verbal solicitations should not be regarded as supplying the place of *proofs*. In all cases that have been at prior sessions before Congress, the dates should be specifically stated as well as the action had thereon, referring to the Nos. and pages of the documents. The constitutional power of Congress to require by law that petitions of any character, or the testimony to sustain a petition, shall be *printed* in advance of presentation, by a petitioner, may be questioned; but all may understand that the great facility afforded for the speedy examination of a case by the printing of the papers exhibiting its merits, and the furnishing each member with a copy, should be a sufficient incentive to cause an applicant for any relief by special act, to adopt such a course. If they will present petitions written so that it is difficult to decypher them, accompanied by a mass of ill-arranged papers, many often wholly irrelevant, it is not strange that delays arise from the inability of committees and members to examine the cases properly. Applicants may find it beneficial not to disregard this suggestion.

Instances have heretofore occurred in which patents, involving

interests to the amount of hundreds of thousands of dollars, have been extended by special act of Congress, and which acts have been complained of as doing injustice to the parties not heard, or whose rights were not considered by Congress. A memorial has, at this very session, been referred to this committee, praying Congress to repeal an act passed in 1845, which extended a patent, in which memorial, signed by sundry citizens of Massachusetts, the express ground is taken, and the express allegation made, that the enactment of the law was procured by "misrepresentation" and by "fraud!" Strict adherence to the rules above suggested, may prevent this accusation being made in future. Another preventive is, the incorporation in every act extending a patent where there are assignees, a provision protecting assignees.

The committee, in the particular case under consideration, inasmuch as it does not conform to these rules, and as no evidence has been adduced, report the following resolution:

*Resolved*, That the prayer of the petition of Herrick Aicken should not be granted.

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The committee, in the particular case under consideration, has much evidence not conform to these rules, and as no evidence has been adduced, report the following resolution:

Resolved, That the prayer of the petition of Harriet Ashton should not be granted.



